

Application No. 10/849,515  
Amendment in response to Office action dated January 24, 2006

Attorney Docket No. FS-F03334-01

### Remarks

#### **1. Amendments to claims**

By the present amendment, claims 1, 7, 14 and 15 have been amended, and claim 13 has been cancelled. The limitations of Claim 13 have been put into Claim 1. No new matter has been added.

Upon entry of the present amendment, claim 1-12, 14 and 15 will be pending in the application.

#### **2. Comments**

##### **Paragraph 3: Rejection of claim 15 under 35 U.S.C.112**

Claim 15 was rejected under 35 U.S.C.112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Applicants respectfully submit that present amendment has corrected any problems with associated with 35 U.S.C.112, second paragraph.

##### **Paragraph 6: Rejection of claims 1-15 under 35 U.S.C.102(e) or U.S.C.103(a)**

Claims 1-15 were rejected under 35 U.S.C.102(e) as being anticipated by or, in alternative, under 35 U.S.C.103(a) as obvious over Oyamada (US 2004/0229173).

Applicants respectfully submit that present amendment renders the claim not anticipated and not obvious in light of the Oyamada reference. Moreover, a certified translation of the Japanese priority document of the present application is being submitted. The priority document, JP Application No. 2003-144,757 antedates the US filing date and publication date of the Oyamada reference.

##### **Paragraph 7: Rejection of claims 1-15 under 35 U.S.C.102(e) or U.S.C.103(a)**

Claims 1-15 were rejected under 35 U.S.C.102(e) as being anticipated by or, in alternative, under 35 U.S.C.103(a) as obvious over Inoue (US 2004/0033,449).

Applicants respectfully point out that Inoue is not an anticipatory reference to any of Claims 1-15. Claim 1 of the present invention requires a back surface protective layer that comprises a binder that contains BOTH a water-soluble

Application No. 10/849,515

Amendment in response to Office action dated January 24, 2006

Attorney Docket No. FS-F03334-01

polymer and a latex polymer having a certain glass transition temperature (support for same can be found in the present specification beginning on page 27). In contrast, Inoue does not disclose the inclusion of both within the binder of the back surface protective layer, and as such, is not anticipatory. More specifically, Table 6 on page 71, as cited by the Examiner, teaches only the inclusion of a latex polymer in the back side protective layer. Table 6 does not teach the inclusion of an additional water soluble polymer in the back side protective layer. Applicants therefore respectfully submit that the anticipation rejection is improper.

Moreover, Inoue does not disclose the new fluoroalkyl limitation of amended claim 1.

As noted above, Applicants are submitting a certified translation of their Japanese priority document which antedates Inoue's 102(a) prior art date of February 19, 2004. Therefore, upon submission of the priority document, Inoue is available as prior art only under 102(e). Applicants respectfully submit that that the current 103(a) obviousness rejection is overcome in light of Applicants' statement of common ownership:

The current application, serial No. 10/849,515 and US 2004/0033449 to Inoue were, at the time the invention of application 10/849,515 was made, both owned by Fuji Photo Film Ltd.

In summary, Inoue is not an anticipatory reference to the present application and can only be used in an obviousness rejection. Inoue is available as prior art only under 102(e). Because the only remaining rejection is based on 103(a) using 102(e) prior art, the rejection is overcome by Applicants' statement of common ownership.

**Paragraph 9: Rejection of claims 1-14 on the ground of nonstatutory obviousness-type double patenting**

Claims 1-14 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9, 14-17, of copending Application No. 10/408,574 to Inoue.

**Paragraph 10 : Rejection of claims 1 on the ground of nonstatutory obviousness-type double patenting**

Claims 1 was provisionally rejected on the ground of nonstatutory

Application No. 10/849,515

Amendment in response to Office action dated January 24, 2006

Attorney Docket No. FS-F03334-01

obviousness-type double patenting as being unpatentable over claims 1, 6, 7, 9, of copending Application No. 10/837,674 to Oyamada.

Both of Applications 10/408,574 and 10/837,674 have a common assignee with the present application. A terminal disclaimer regarding Applications 10/408,574 and 10/837,674 is being filed herewith.

In view of the foregoing amendments and remarks, it is respectfully submitted that all of the pending claims are in condition for allowance. Favorable action is respectfully requested.

Respectfully submitted,



Sheldon J. Moss

Registration No. 52,053

TAIYO, NAKAJIMA & KATO  
401 Holland Lane, Suite 407  
Alexandria, VA 22314  
Telephone: (703) 838-8013  
Date: May 24, 2006